

Appl. No. : 09/252,842
Filed : February 19, 1999

REMARKS

The Applicants have amended Claims 1, 20, 22 and 24. The specific changes to the amended claims are shown above, wherein the insertions are underlined and the ~~deletions are stricken through~~. The Applicants respond below to rejections raised by the Examiner in the Office Action of April 9, 2003.

I. Rejections Under 35 U.S.C. § 102

The Examiner has rejected Claim 22 under 35 U.S.C. § 102(e) as allegedly being anticipated by Davis Jr. *et al.* (U.S. Patent No. 5,647,724). The Applicants respectfully traverse.

Davis Jr. *et al.* teaches a substrate transport apparatus having dual substrate holders. The Examiner has proposed that “[o]ne of the substrate holders can be retrieving a substrate from the a [sic] storage module while the other acts as a buffer and temporarily holds the substrate before transferring to a process chamber.” However, the Applicants respectfully submit that no component of the device described in Davis Jr. *et al.*, including the substrate holders, is able to act as a “buffer” as that term appears in Claim 22. Claim 22, as amended, recites “a chemical storage buffer coupled to and moving with said moving automated chemical retriever for receiving and temporarily storing chemicals retrieved from said storage locations by said robotic apparatus.” Accordingly, when the device of Claim 22 operates, the robotic apparatus retrieves chemicals from a storage location and delivers them to the buffer for temporary storage. In the device of Davis Jr. *et al.*, either of the dual substrate holders might be viewed as part of the robotic apparatus for retrieving, but it would not be consistent to suggest that while one substrate holder is retrieving, the other substrate holder acts as a “buffer” since there is never a transfer of retrieved chemicals between the two. Indeed, the buffer of Claim 22 must be “for receiving and temporarily storing chemicals retrieved from said storage locations by said robotic apparatus.” No element of the Davis Jr. *et al.* device satisfies this requirement. Accordingly, Claim 22 and its dependent claim, Claim 23, are patentable over the prior art of record.

II. Rejections Under 35 U.S.C. § 103

Claims 1-3, 20-21, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelso *et al.* (WO 93/12431), and Claims 6 and 23 stand rejected under 103(a) as being unpatentable over Kelso *et al.* in view of Davis Jr. *et al.* The Applicants respectfully traverse.

The device disclosed in Kelso *et al.* has been discussed in previous Responses by the Applicants and is a device that dilutes biological samples obtained from patients and then

conducts certain assays on the diluted samples. When the device of Kelso *et al.* operates, samples are drawn sequentially, from beginning to end. In contrast, Claim 1 requires that the system be "programmable via a user interface to retrieve and handle either (a) the samples from every one of the chemical wells of said at least one multiwell plate or (b) the samples from a subset of chemical wells within said at least one multiwell plate." The Applicants note that the Examiner has proposed that these features are "presented in an alternative expression, therefore the reference need only perform the function under (a) or (b), not both." Office Action at page 6, lines 9-10. However, the Applicants respectfully submit that the term "programmable" in this context means that the system must accept programming such that it will perform according to "(a)" when appropriately programmed by a user, and will perform according to "(b)" when appropriately programmed by a user.

One embodiment that includes such programmability is depicted in FIGS. 10A and 10B of the present specification. FIG. 10A shows a computer interface wherein the user may select "By Samples" when conducting an assay. FIG. 10B shows a flowchart for selecting by samples. In FIG. 10B, the step of "Select or Exclude Samples" features options such as: "Select All," "Select Properties," "Select Previous," "Select by Source," "Select by Date (expires, entered)," and "Import List." There is no teaching in Kelso *et al.* of such programmability; indeed, there is no teaching in Kelso *et al.* of the option of retrieving a subset. Accordingly, Claim 1 is patentable over the prior art of record. Further, Claims 2, 3, and 6, which depend from Claim 1, are patentable for at least the same reasons.

Next, Claims 20 and 24 contain similar language as Claim 1 with respect to the "programmable via a user interface to retrieve" limitation. Accordingly, a system covered by Claims 20 or 24 would also have to be able to undergo programming that allow it to function under "(a)" on some occasions and under "(b)" on other occasions. Accordingly, Claims 20 and 24 are patentable over the prior art of record as well. Further, Claim 21, which depends from Claim 20, is patentable for at least the same reasons.

Finally, Claim 23 depends from Claim 22 which has been amended and is discussed in the previous section.

None of the cited references, either alone or in combination, disclose, teach, or suggest the presently claimed invention. Since a number of the elements of the independent claims are not disclosed or suggested by the cited references, the references either alone or in combination

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do not anticipate nor render obvious the claimed invention. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw the rejections. Claims 1-3, 6, and 20-24 are pending in the application. The Applicants respectfully submit that all claims are now in condition for allowance.

CONCLUSION

The Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims pursuant to the Examiner's rejections under §§ 102 and 103, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. In light of these amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and it is respectfully submitted that the claims satisfy the statutory requirements for patentability without the entry of such amendments. These amendments have only been made to increase claim readability, to improve grammar, or to reduce the time and effort required of those in the art to clearly understand the scope of the claim language.

If the Examiner has any questions which may be answered by telephone, she is invited to call the undersigned directly.

Respectfully submitted,

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